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| 09/990,424 | 11/21/2001 | Amit Haller | IXIM-01004US0 | 3635 |
| 28554 | 7590 | 02/25/2004 | EXAMINER | |
| VIERRA MAGEN MARCUS HARMON & DENIRO LLP 685 MARKET STREET, SUITE 540 SAN FRANCISCO, CA 94105 | | | SCHULTZ, WILLIAM C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2664 | |

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,424

Applicant(s)

HALLER ET AL.

Examiner

William C. Schultz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38 and 41 is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 15-21, 23, 24, 26-36, 39 and 42 is/are rejected.
- 7) ☒ Claim(s) 5-7, 9, 12-14, 22, 25, 37, 40 and 43-45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6, 7, 8, 11.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 10/07/2002, 4/21/2003, 7/31/2003, 12/22/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4,8,10,11,15,16-21,23-24,26-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 1-4,8,10,11,15,16-21,23-24,26-34, the phrase "capable of" renders the claim indefinite because the limitation suggests or makes optional the particular structure of the system and therefore is not a required part of the claimed invention. See MPEP § 2106(II).C.para 4

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,17,18,20,23,35,36,39,42 are rejected under 35 U.S.C. 102(e) as being anticipated by Gernert et al. [U.S. Pat. 6,600,734].

Regarding claims 1,23, Gernert et al. discloses a system for forming a short distance wireless network, comprising:

a first device capable(**fig. 4; col. 10, lines 65-68**) of generating a first short-range radio signal (**col. 12, lines 46-50, 55-57**) including a first identification symbol responsive to a user input;**(col. 14, lines 27-31,50-56; col. 15, lines 5-8, 25-29, 37-43)** and,

a second device(**fig. 3**) capable of receiving the first short-range radio signal and generating a second short-range radio signal to the first device (**col. 8, lines 8-21**) responsive to comparing the first identification symbol to a second identification symbol, (**col. 14, lines 27-31,50-56; col. 15, lines 5-8, 25-29, 37-43 – comparsion to a second identification symbol is not disclosed however from the applicant's spec starting on page 11, line 21 to page 14, line 12; the applicant discloses that the comparision of the entered PIN is with a saved PIN in a database that should be the same PIN, not a wholly different second identification symbol as claimed. The reference discloses authenticating using a PIN to which the PIN has data other associated to it in a database. Inherently, The entered PIN could not be associated to the database PIN unless it is compared after transmission to the device in fig. 3.)**

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wherein the second device is capable of communicating with a wide area network by cellular signals. **(col. 8, lines 64-68)**

Further regarding claim 23, the second device is shown above verifying the first identification symbol.

Regarding claim 17, Gernert et al. discloses a system for forming a short distance wireless network, comprising:

a first device capable(**fig. 3**) of generating a short-range radio signal responsive to receiving a pairing message; and, **(col. 14, lines 27-31,50-56; col. 15, lines 5-8, 25-29, 37-43)**

a second device(**fig. 4; col. 10, lines 65-68**) capable of generating a short-range radio signal(**col. 12, lines 46-50, 55-57**) including a first identification symbol, wherein the first and second devices communicate responsive to the pairing message and the first identification symbol, ;(**col. 14, lines 27-31,50-56; col. 15, lines 5-8, 25-29, 37-43**) wherein the second device is selected from a group consisting of a desktop computer, a laptop computer, a personal digital assistant, a headset, a pager, a printer, a watch, and a digital camera. **(col. 7, lines 14-24)**

Regarding claims 18,20, Gernert et al. discloses a system for forming a short distance wireless network, comprising:

a first device capable(**fig. 3**) including a short-range radio processor **(col. 11, lines 24-27)** and a 2.4 GHz transceiver **(col. 11, lines 30-34)** capable of generating a short-range radio signal responsive to receiving a pairing message; and, **(col. 14, lines 27-31,50-56; col. 15, lines 5-8, 25-29, 37-43)**

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a second device(**fig. 4; col. 10, lines 65-68**) capable of generating a short-range radio signal(**col. 12, lines 46-50, 55-57**) including a first identification symbol, wherein the first and second devices communicate responsive to the pairing message and the first identification symbol, ;(**col. 14, lines 27-31,50-56; col. 15, lines 5-8, 25-29, 37-43**) wherein the second device is selected from a group consisting of a desktop computer, a laptop computer, a personal digital assistant, a headset, a pager, a printer, a watch, and a digital camera. (**col. 7, lines 14-24**)

Further regarding claim 20, Gernert et al. discloses the mobile device sending transmissions with a 2.4 GHz transceiver but fails to disclose the gateway device is receiving/transmitting with a 2.4 GHz transceiver. Inherently the access gateway must have a 2.4 GHz transceiver so that the signals from/to the mobile can be received/transmitted, if not the whole system would fail to operate as disclosed.

Regarding claims 35,42, Gernert et al. discloses a method for adding a first device to a short distance wireless network having a second device, comprising the steps of providing an identification symbol to the first device; (**col. 14, lines 27-31,50-56; col. 15, lines 5-8, 25-29, 37-43**)

generating a short-range radio signal containing the identification symbol to the second device from the first device; (**col. 12, lines 46-50, 55-57**)

forming a short-range radio communication channel between the first device and the second device responsive the identification symbol.;and, (**col. 14, lines 54-56 – assigning the address is explicitly forming a channel of communication**)

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forming a cellular communication channel between the second device and a wide area network. (col. 14, lines 56-61 – the WAN connection gets a telephone number on the PSTN, this is forming a channel on the WAN in a wired environment. In ,col. 12, lines 46-50, 55-57, Gernert discloses the WAN connection could be a cellular link, so the previous citation is expressive of forming a channel with the wan connection no matter what medium it happens to be.)

Regarding claim 36, Gernert et al. further discloses the steps of: providing a pairing message to the second device and forming a short-range radio communication channel responsive to the pairing message. (col. 14, lines 27-31,50-56; col. 15, lines 5-8, 25-29, 37-43)

Regarding claim 39, Gernert et al. further discloses the pairing message is generated in response to a user input at a telephone. (col. 14, lines 50-54)

Allowable Subject Matter

Claim 38,41 is allowed.

Claims 5-7,9,12-14,22,25,37,40,43-45 are objected to as being dependent upon a rejected base claim.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shoobridge et al. [U.S. Pat. 6,326,926] – Wireless device having two wireless interfaces one for 802.11 communication, in which it terms this as cellular communication the other for bluetooth communication.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Schultz whose telephone number is 703-305-2367. The examiner can normally be reached on M-F(7-4)(first bi-week) M-Th(7-4)(second bi-week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 703-305-4366. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William Schultz


Ajit Patel
Primary Examiner